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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/260,837      | 03/02/1999  | DARYL LAWTON         | 187831              | 6978             |

7590

04/09/2004

LEYDIG VOIT & MAYER  
TWO PRUDENTIAL PLAZA SUITE 4900  
180 NORTH STETSON  
CHICAGO, IL 606016780

EXAMINER

SINGH, RACHNA

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2176

DATE MAILED: 04/09/2004

17

Please find below and/or attached an Office communication concerning this application or proceeding.

2

**Advisory Action**

Application No.

09/260,837

Applicant(s)

LAWTON ET AL.

Examiner

Rachna Singh

Art Unit

2176

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 16 March 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: \_\_\_\_\_

Claim(s) withdrawn from consideration: \_\_\_\_\_

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☐ Other: \_\_\_\_\_

  
JOSEPH FEILD  
SUPERVISORY PATENT EXAMINER

Continuation of 5. does NOT place the application in condition for allowance because: Applicant argues the motivation used to combine references in the office action. Specifically, Applicant argues that Examiner has not presented reasons why one of ordinary skill in the art would have made the alleged combination. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, W3C disclosure teaches that XML applications provide for the ability to link to a portion of a document from a document model. See abstract. Furthermore, it was well known in the art at the time of the invention to provide reduced images (thumbnails) from which a user could select coordinates linking to the larger document, as taught in GroupLab's thumbnail registration with a document. Both thumbnails and DOM provide users with the ability to link to another document by providing a "mapping" to a data structure. Thus it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the features taught by GroupLab (i.e. thumbnail registration with a document structure) with W3C's teachings of providing a link between a document model and portion of a document since it provides the user with the ability to communicate with another document. See pages 1-2 of W3C disclosure section "What is a Document Object Model" where a DOM. Examiner's combination is based on the knowledge available to one of ordinary skill in the art at the time of the invention that a DOM provides a representation of the structure of a document and a reduced image (thumbnail) was often used to represent a document through the coordinate mapping of a document's structure to the thumbnail (see figure 1 of GroupLab reference). Thus given that these two features were well known in the art at the time as a means for linking to a document, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the two references as the mapping of a DOM or structure of an XML document would be the next logical step in representing the structure of a document in a reduced image format since it already took into account the structure of a document.

See previous office action..